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**REMARKS**

Applicant appreciates the Examiner's decision to withdraw all previous grounds of rejection of claims 1-7 and 9-19, which remain pending in the application.

Claims 1-2, 6, 9-10, 12 and 14-18 are rejected under 35 U.S.C. §103(a) as being "unpatentable" over Karpinski (U.S. Patent No. 4,304,824) in view of Lynn et al. (U.S. Patent No. 6,093,481).

Claims 3-5 are rejected under 35 U.S.C. §103(a) as being "unpatentable" over Karpinski in view of Lynn et al., as applied to claims 1-2, 6, 9-10, 12, and 14-18 above, and further in view of Gluck et al. (U.S. Patent No. 4,438,166).

Claim 7 is rejected under 35 U.S.C. §103(a) as being "unpatentable" over Karpinski in view of Lynn et al., as applied to claims 1-2, 6, 9-10, 12, and 14-18 above, and further in view of Nozimo et al. (U.S. Patent No. 5,366,678).

Claims 11 and 13 are rejected under 35 U.S.C. §103(a) as being "unpatentable" over Karpinski in view of Lynn et al., as applied to claims 1-2, 6, 9-10, 12, and 14-18 above, and further in view of Altenberg (U.S. Patent No. 6,096,416).

Claim 19 is rejected under 35 U.S.C. §103(a) as being "unpatentable" over Karpinski in view of Lynn et al., as applied to claims 1-2, 6, 9-10, 12, and 14-18 above, and further in view of Facciano et al. (U.S. Patent No. 6,343,954 B1).

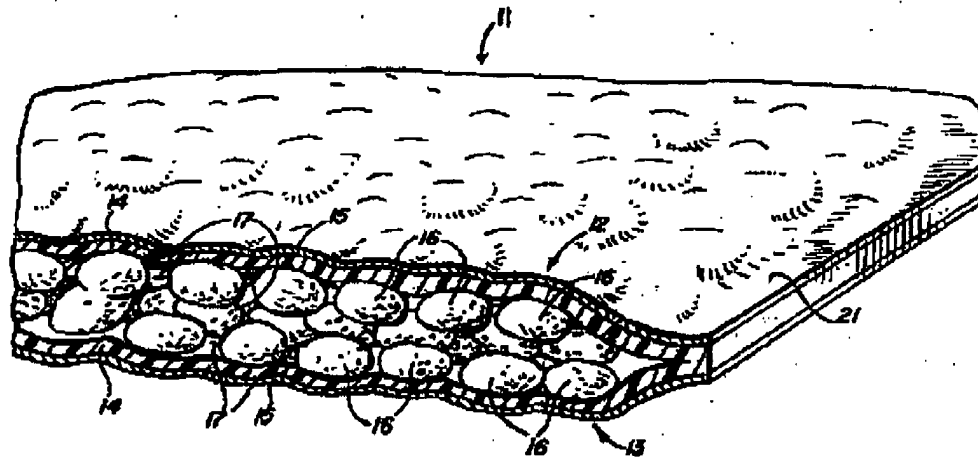
**Amendment to claim 9**

Preliminarily, Applicant wishes to note that a formal amendment is made to dependent claim 9 to make "insulators" singular. This is the only change made to the claims, and is not believed to impact the substantive issues raised by the Examiner in any way.

**Rejection of claims 1-2, 6, 9-10, 12 and 14-18 under 35 U.S.C. §103(a)**

Claims 1-2, 6, 9-10, 12 and 14-18 are rejected under 35 U.S.C. §103(a) as being "unpatentable" over Karpinski (U.S. Patent No. 4,304,824) in view of Lynn et al. (U.S. Patent No. 6,093,481). Applicant respectfully traverses the Examiner's rejection.

Karpinski discloses "a flexible modular insulation quilt . . . having two thin flexible layers fused to the borders and surrounding a plurality of shaped foam material in a vacuum" (Abstract). In the embodiment relied on by the Examiner, these layers take the form of "opposed flexible laminate films 12 and 13," each comprising "a first flexible film 14 *on the inner surface* and an outer flexible film 15 . . . *on the outer surface*" (col. 2, ll. 21-28) (Emphasis added). The "flexible laminate *films* 12 enclose a plurality of pellets 16 of low conduction material, such as expanded polystyrene foamed pellets . . ." (col. 2, ll. 28-30) (Emphasis added). This arrangement is illustrated in Figure 1:



In formulating the extant rejections, the Examiner contends that "Karpinski teach [sic teaches] an acoustical and thermal insulator . . . comprising a multiplayer [sic multi-layer] composite including a first facing layer (15 from Fig. 1 and col. 2, ll. 20-47, a polymer based blanket layer (14 from Fig. 1 and col. 2, ll. 20-47) and an insulation insert (16 from Fig. 1 and col. 2, ll. 20-47) *encapsulated by said first facing material layer and said polymer based blanket layer. . .*" (Emphasis added). Applicant respectfully submits that this contention is simply not true. The pellets 16 equated with the insulation insert 16 are plainly not "encapsulated by" either of the layers 14, 15 allegedly corresponding to the facing material layer and the polymer based blanket layer required by claim 1.

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Accordingly, it is *not* the case that "Karpinski discloses applicant's invention substantially as claimed," as posited throughout the Office Action.

Besides the various other distinctions emphasized in past responses, the secondary Lynn et al. patent does not teach or suggest any type of insulation insert "encapsulated" by a facing material layer and an insulation blanket layer. For this reason alone, it cannot supply the teaching missing from the primary Karpinski reference that would render the invention of claim 1 or any of the claims that depend therefrom obvious. Stated another way, the cited references, whether taken alone or together, fail to teach or suggest an insulation insert encapsulated by a facing material layer and a blanket layer, as expressly required by claim 1. Accordingly, a *prima facie* case of obviousness is lacking, and the rejection of this claim must be withdrawn. See Section 2143.03 MPEP, ch. 2100, p. 133 ("To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art."); Section 2142 MPEP, ch. 2100, p. 110 ("[i]f the examiner does not establish a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness."); In re Ochiai, 71 F.3d 1565, 37 U.S.P.Q.2d 1127 (Fed. Cir. 1995), *citing In re Fine*, 837 F.2d 1071, 1075, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988) ("When the references cited by the Examiner fail to establish a *prima facie* case of obviousness, the rejection is improper and will be overturned.").

Applicant further notes that in explaining why these two references when combined allegedly meet the terms of claims 1-2, 6, 9-10, 12 and 14-18 in the paragraph beginning at the bottom of page 5 of the Office Action and bridging over to the top of page 6, the requirement in claim 1 of an insulation insert encapsulated by the first facing material layer and the polymer based blanket layer is completely overlooked. Furthermore, the Examiner admits that "Karpinski fails to disclose an acoustical and thermal insulator comprising a multiplayer [*sic* multi-layer] composite including a *fibrous* first facing material . . ." (Emphasis added), but fails to establish that Lynn et al. discloses such a facing material.

Axiomatically, "[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art." Section 2143.03 MPEP, ch. 2100, p. 133.

Since the requirement for an insulation insert expressly appears in claim 1, it is improper to ignore it completely in assessing the obviousness of the invention. The same is true of the express requirement of a fibrous first facing material layer.

Regardless of whether Karpinski and Lynn et al. together meet the terms of claim 1, the requisite motivation to combine these references is also lacking. Emphasis is placed throughout the Lynn et al. patent on the rigidity of the foam (including foam made of "rigid cellular polymers"; col. 5, l. 47). In stark contrast, Karpinski is limited to flexible insulators, (see Abstract), and in fact disparages rigid insulators (see col. 1, ll. 49-51). No convincing explanation based on objective evidence reveals why a skilled artisan would be motivated to combine these disparate teachings. This means that a *prima facie* case of obviousness is lacking for this additional reason. Section 2143.01 MPEP, ch. 2100, p. 131 ("The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.") (Emphasis in original).

With respect to dependent claims 2, 6, 9-10, 12 and 14-18, it has been demonstrated that the combination of references cited fail to render claim 1 "unpatentable" as obvious under Section 103(a), as contended. Of course, any claim depending from a nonobvious claim is nonobvious as well. Section 2143.03 MPEP, ch. 2100, p. 133. Accordingly, the rejections of these and the other claims are believed to be improper and should be withdrawn.

Notwithstanding the foregoing, the independent patentability of dependent claim 18 is also overlooked. Besides the "first" insulation insert of claim 1, this claim further requires "a second insulation insert encapsulated by" the first facing material layer and the polymer based blanket layer adjacent the first insert. Since neither Karpinski nor Lynn et al. disclose a single insulation insert encapsulated by a facing layer and a polymer based blanket layer, these references certainly cannot teach the desirability of providing many such inserts. Accordingly, a *prima facie* case of obviousness is lacking with respect to dependent claim 18 for this additional reason.

In light of the foregoing, Applicant respectfully submits that the rejections of claim 1 and all claims that depend therefrom are improper and must be withdrawn.

**Rejection of claims 3-5 under 35 U.S.C. §103(a)**

As noted above, dependent claims 3-5 are rejected under 35 U.S.C. §103(a) as being "unpatentable" over Karpinski in view of Lynn et al., in further view of Gluck et al. Applicant respectfully traverses the Examiner's rejection for reasons similar to those provided above; namely, that Karpinski does not "disclose applicant's invention substantially as claimed." Specifically, Karpinski fails to disclose an insulation insert encapsulated by a first facing layer and a polymer based blanket layer. Since the tertiary Gluck et al. reference does not disclose this feature, it does not supply this teaching missing from the primary Karpinski reference or the secondary Lynn et al. reference that would render the invention of claim 1 or its progeny, including dependent claims 3-5, "obvious."

**Rejection of claim 7 under 35 U.S.C. §103(a)**

Dependent claim 7 is rejected under 35 U.S.C. §103(a) as being "unpatentable" over Karpinski in view of Lynn et al., in further view of Nozimo et al. Applicant respectfully traverses the Examiner's rejection because Karpinski does not "disclose applicant's invention substantially as claimed." Specifically, Karpinski fails to disclose an insulation insert encapsulated by a first facing layer and a polymer based blanket layer. Since the tertiary Nozimo et al. reference does not disclose this feature, it does not supply this teaching missing from the primary Karpinski reference or the secondary Lynn et al. reference that would render the invention of claim 1 or its progeny, including dependent claim 7, "obvious."

**Rejection of claims 11 and 13 under 35 U.S.C. §103(a)**

Dependent claims 11 and 13 are rejected under 35 U.S.C. §103(a) as being "unpatentable" over Karpinski in view of Lynn et al., in further view of Altenberg. Again,

Karpinski does not "disclose applicant's invention substantially as claimed." Specifically, Karpinski fails to disclose an insulation insert encapsulated by a first facing layer and a polymer based blanket layer. Since the tertiary Altenberg reference does not disclose this feature, it does not supply this teaching missing from the primary Karpinski reference or the secondary Lynn et al. reference that would render the invention of claim 1 or its progeny, including dependent claims 11 or 13, "obvious."

**Rejection of claim 19 under 35 U.S.C. §103(a)**

Finally, dependent claim 19 is rejected under 35 U.S.C. §103(a) as being "unpatentable" over Karpinski in view of Lynn et al., in further view of Facciano et al. First of all, Applicant respectfully traverses the Examiner's rejection for reasons similar to those provided above; namely, that Karpinski does not "disclose applicant's invention substantially as claimed." Specifically, Karpinski fails to disclose an insulation insert encapsulated by a first facing layer and a polymer based blanket layer. Since the tertiary Facciano et al. reference does not disclose this feature, it does not supply this teaching missing from the primary Karpinski reference or the secondary Lynn et al. reference that would render the invention of claim 1 or its progeny, including dependent claim 19, "obvious."

Secondly, Applicant respectfully disagrees with the contention that Facciano et al. is "analogous." Facciano et al. relates to "an improved electrical interconnection assembly adaptable for creating electrical connections between spaced-apart sections of a high performance missile assembly." (Abstract). Plainly, this patent has nothing to do with thermal and acoustic insulators of the type claimed, even if useful in building construction as the Examiner contends. A skilled artisan looking to improve upon the flexible arrangements shown, for example, in the Karpinski patent would simply not look to the missile harness art for solutions.

As recently observed by the CAFC, "it is necessary to consider the 'reality of the circumstances' - in other words, common sense - in deciding in which fields a person of

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ordinary skill would reasonably be expected to look for a solution to the problem facing the inventor."<sup>1</sup> Moreover, the Examiner "must consider the 'circumstances' of the application - the full disclosure - and weigh those circumstances from the vantage point of the common sense likely to be exerted by one of ordinary skill in the art in assessing the scope of the endeavor."<sup>2</sup> Merely stating that "the references" (presumably only Karpinski and Facciano et al.) are analogous "since both are drawn to encapsulated insulation inserts" falls short of meeting this requirement, since Applicant's disclosed invention comprises more than just an insulation insert for all-purpose use. Accordingly, it is believed that the Examiner's reliance on Facciano et al. is misplaced.

### CONCLUSION

In view of the foregoing amendments and remarks, Applicant submits that claims 1-7 and 9-19 are in proper form and allowable over the cited prior art. The Examiner is invited to telephone the undersigned at (740) 321-7167 if any unresolved matters remain, and may debit any fees due from Deposit Account 50-0568.

Respectfully submitted,

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Dated: 12-22-04

<sup>1</sup> In re Bigio, 381 F.3d 1320; 2004 U.S. App. LEXIS 17981; 72 U.S.P.Q.2D (BNA) 1209 (Fed. Cir. 2004).

<sup>2</sup> Id.